

ESTTA Tracking number: **ESTTA531466**

Filing date: **04/10/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Larry Pitt & Associates, P.C.		
Entity	Corporation	Citizenship	Pennsylvania
Address	1918 Pine Street Philadelphia, PA 19146 UNITED STATES		

Attorney information	Jacqueline M. Lesser Woodcock Washburn LLP 2929 Arch Street Cira Centre, 12th Floor Philadelphia, PA 19104-2891 UNITED STATES trademarks@woodcock.com, jlesser@woodcock.com, jdale@woodcock.com Phone:215-568-3100
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### Applicant Information

Application No	85767757	Publication date	04/09/2013
Opposition Filing Date	04/10/2013	Opposition Period Ends	05/09/2013
Applicant	Lundy Law, LLP 19th Floor 1635 Market Street Philadelphia, PA 19103 UNITED STATES		

### Goods/Services Affected by Opposition

Class 045. First Use: 2011/05/16 First Use In Commerce: 2011/05/16  
All goods and services in the class are opposed, namely: Legal services

### Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
Genericness	Trademark Act section 23

Attachments	Executed Notice of Opposition(000469-4-10-2013 2-20-36 PM).PDF ( 5 pages ) (48368 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jacqueline M. Lesser/
Name	Jacqueline M. Lesser
Date	04/10/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LARRY PITT & ASSOCIATES, P.C.

Opposer,

v.

LUNDY LAW, LLP

Applicant.

In Re: Application of Lundy Law, LLP

Serial No.: 85/767,757

Filed: October 31, 2012

Published: April 9, 2013

Mark: REMEMBER THIS NAME

Opposition No.:

**NOTICE OF OPPOSITION**

Opposer, Larry Pitt & Associates, P.C. (“Opposer”) believes that it would be damaged by registration of the mark as shown in U.S. Application Serial No. 85/767,757, published for opposition on April 9, 2013. As grounds for its opposition, Opposer alleges as follows:

1. Opposer is a law firm located in the Philadelphia area that has been in operation for over thirty-two years, and handles workers compensation claims, personal injury matters and social security disability matters. Opposer’s principal place of business is located at 409 South 20<sup>th</sup> Street, Philadelphia, PA 19146.
2. Since its inception, Opposer has advertised its legal services in various media channels.
3. Opposer’s advertising consistently presents the name and the toll-free telephone number for its firm.

4. As a general matter, marketers and advertisers of legal services promote their services through advertisements which encourage customers to remember the name of the law firm in question, and to remember the firm's telephone number, so that a potential client may call the law firm to engage it for legal services.
5. For example, potential clients of Opposer's legal services often learn about Opposer and its business from its advertising, and contact Opposer because they have reviewed, and remembered the name of Opposer's firm, and its toll-free number.
6. The concept of remembering a law firm's name and its telephone number is well known in the legal community, and by advertisers and marketers of legal services, as well as advertisers and marketers of other services promoted through advertising. On information and belief, Applicant's own marketing efforts are likewise directed to potential customers remembering the name of its own law firm.
7. Applicant has filed an application for REMEMBER THIS NAME for "legal services."
8. Applicant's proposed mark, REMEMBER THIS NAME, is a generic term and therefore Applicant does not have the right to exclude others from using this phrase in its generic sense.
9. Applicant's proposed REMEMBER THIS NAME mark, which is generic, belongs in the public domain rather than to Applicant as its exclusive owner.
10. Applicant's purported mark REMEMBER THIS NAME, if not generic, is at best merely descriptive insofar as it is nothing more than an instruction to potential clients to remember the name of Applicant's law firm, Lundy Law, and such therefore is not capable, itself, of identifying and distinguishing a single source.

11. REMEMBER THIS NAME is an ordinary marketing and advertising concept that is used generally in the industry and by the press to describe marketing efforts, and is a generic or merely descriptive term when applied to the marketing of legal services.
12. Applicant's specimen of use for REMEMBER THIS NAME merely uses the term as an instruction in the body of the ad and does not show the use of the phrase as a trademark, or source identifier.
13. Applicant has intentionally filed for REMEMBER THIS NAME solely to prevent its competitors from instructing their own potential clients to remember such firms' name, and such firm's telephone numbers.
14. Competitors of Applicant, including Opposer are entitled to use the phrase "remember this name" or "remember this number" or similar phrases in their own advertising for legal services without threat of suit.
15. As of the date of this Opposition, Applicant is attempting to foreclose Opposer's use of the common, descriptive instruction to "Remember this number" over Opposer's telephone number on Opposer's own advertising, on the theory that any purported rights that Applicant has in REMEMBER THIS NAME precludes Opposer's right to use the instruction "remember this number" in Opposer's own advertising. Applicant has filed suit in the United States District Court for the Eastern District of Pennsylvania, Civil Action No. 2:13-cv-01161-CDJ, alleging, *inter alia*, that Opposer's use of the phrase "Remember this number" before Opposer's telephone number constitutes an infringement of Applicant's trademark rights in REMEMBER THIS NAME.

16. If Applicant obtains the registration herein opposed, it would obtain the *prima facie* exclusive right to use the generic, or common descriptive phrase REMEMBER THIS NAME for attorney advertising. Such registration would be a source of damage and injury to Opposer (and others) who currently use, or will use, the descriptive designation “remember this name,” “remember this number” or other uses of “remember this” (to which Applicant also claims exclusive rights for its services) in advertising to describe and promote such competitors’ legal services, since it may subject them, as it has subjected Opposer, to an infringement suit.
17. Registration should therefore be refused pursuant to Section 2(e)(1) of the Trademark Act of 1946, as amended, 15 U.S.C. §1052 (e)(1), on the grounds that Applicant’s REMEMBER THIS NAME mark is a generic term, or, at best, a merely descriptive term.

WHEREFORE, Opposer, Larry Pitt & Associates prays that allowance of Serial No. 85/767,757 be refused, and that the Board sustain this opposition.

Respectfully submitted,

Dated: April 10, 2013

By: **WOODCOCK WASHBURN LLP**



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Jacqueline M. Lesser, Esq.  
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*Attorneys for Opposer  
Larry Pitt & Associates, P.C.*

**CERTIFICATE OF SERVICE**

I, Jacqueline M. Lesser, hereby certified that a true and correct copy of the foregoing Notice of Opposition was served on counsel for Applicant:

Manny D. Pokotilow, Esq.  
Caesar, Rivise, Bernstein, Cohen & Pokotilow  
1635 Market Street  
12<sup>th</sup> Floor  
Seven Penn Center  
Philadelphia, PA 19103

Postage prepaid by first class mail on April 10, 2013.

Executed on April 10, 2013, at Philadelphia, Pennsylvania.

  
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Jacqueline M. Lesser